



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,955	09/26/2003	Eric Ustaris	200209831-1	9436
22879 7590 12/13/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER RIMELL, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2164	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

Office Action Summary

Application No.

10/672,955

Applicant(s)

USTARIS, ERIC

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is inoperable and therefore lacking utility.

Claim 1: Claim 1 calls for software being provided to a workstation, causing the workstation to be re-configured as a server. The term "software" is broad enough to encompass any and all possible software, and the vast majority of all possible software will not cause a workstation to be re-configured to function as a server. Accordingly, the claim recites the impossible condition of having any possible software causing a workstation to be re-configured as a server, and thus is inoperable for reciting an impossible condition.

Claims 2-6: Depend on claim 1.

Claim 7: Claim 7 recites a workstation "adapted to cause" client applications to be transferred to the workstation so that the workstation is re-configured as a server. This claim is inoperable for two separate reasons: (1) The claim does not have a mandatory requirement to transfer the re-configuring application to the workstation. Lacking any transfer of applications to the workstation, the re-configuring would never take place. (2) The term "client application" is broad enough to encompass any and all possible client applications, and the vast majority of all possible client applications will not cause a workstation to be re-configured to function as a server. Accordingly, the claim recites the impossible condition of having any possible client application causing a workstation to be re-configured as a server, and thus is inoperable for reciting an impossible condition.

Claims 8-11: Depend on claim 7.

Claim 15: Claim 15 calls for a means for transferring client applications to a means for executing. This claim is inoperable for two separate reasons: (1) The claim does not have a mandatory requirement to actually transfer the re-configuring application to the means for executing. Lacking any transfer of applications to the means for executing, the re-configuring would never take place. (2) The term "client application" is broad enough to encompass any and all possible client applications, and the vast majority of all possible client applications will not cause a workstation to be re-configured to function as a server. Accordingly, the claim recites the impossible condition of having any possible client application causing a workstation to be re-configured as a server, and thus is inoperable for reciting an impossible condition.

Claim 16: Depends on claim 15.

Claim 17: The term "client application" is broad enough to encompass any and all possible client applications, and the vast majority of all possible client applications will not cause a workstation to be re-configured to function as a server. Accordingly, the claim recites the impossible condition of having any possible client application causing a workstation to be re-configured as a server, and thus is inoperable for reciting an impossible condition.

Claims 18-20: Claims 1, 7 and 17.

Remarks

Although no prior art is applied, no indications of allowable subject matter are made due to the utility issues under 35 USC 101.

Two fundamental issues exist in the record. All of the independent claims of record call for any manner of software or application to re-configure a computer to function as a server,

whereas it is not possible for all forms of software to perform this function. Additionally, claims 7 and 15 do not even require that the software actually be transferred, which means that the re-configuring function would not take place even if the specific software needed to accomplish it were recited as being present.

In general, the claims should be further amended to recite the specific software needed to accomplish the re-configuration, and clarified to recite that this necessary software will be transferred to the workstation or client actually being re-configured.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number:
10/672,955
Art Unit: 2164

Page 5

Any inquiry concerning this communication should be directed to Sam Rimell at
telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'Sam Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
Art Unit 2164